

RESPONSE under 37 C.F.R. § 1.116  
U.S. Appln. No. 09/745,923

**REMARKS**

Claims 1-20 are all the claims pending in the application and stand rejected. Reconsideration and allowance of all pending claims are respectfully requested in view of the foregoing amendments and following remarks.

**ENTRY OF AMENDMENT.**

By this amendment Applicant amends claim 11 to recite limitations similar to those already present in independent claims 1 and 17. Accordingly, additional consideration and/or search is not required by the Examiner and this amendment should be entered in accordance with 37 C.F.R. 1.116.

**CLAIM REJECTIONS.**

**35 U.S.C. § 102**

Claims 11-20 are rejected under 35 U.S.C. § 102(b) as being anticipated by U.S. Patent 5,898,933 to Kaschke. Applicant respectfully traverses this rejection for the following reasons.

Kaschke discloses a radio telephone 200 having an antenna 213 that cooperate to provide wireless transceiving communications between phone 200 and a cellular radiotelephone system. (Col. 3, ll. 51-67). Antenna 213 may be extended or retracted to/from phone 200 depending on whether phone 200 is in use. Phone 200 is configured for enabling or disabling a predetermined operating mode responsive to antenna's 213 position. (Col. 4, ll. 5-13).

Extending antenna 213 may ready phone 200 to answer a telephone call or ready the phone to make a call; this is referred to by Kaschke as enabling an "off-hook" mode. (Col. 5, ll. 3-8). The user may terminate a telephone call by retracting antenna 213. Such a retracted state of the antenna is referred to as an "on-hook" state. (Col. 5, ll. 14-19). The "on-hook" and "off-hook" terms are derived from the state of a hand set in conventional telephones. That is, when

RESPONSE under 37 C.F.R. § 1.116  
U.S. Appln. No. 09/745,923

the hand set is resting on the base portion, the telephone is "on-hook" whereby the telephone is in a mode operative to end a call or receive a call but not to transmit a call. Moreover, when the hand set is removed from the base portion, the telephone is "off-hook" whereby the telephone is in a mode operative to transmit a call but not receive a call. In either position, a communication module associated with phone 200 is not disabled. Rather, the "on-hook" state or "off-hook" state relate to enabling or disabling a particular operational mode of a communication module. (Abstract).

By way of contrast, Applicant's independent claim 17 recites a method comprising:

*disabling a communication module in a portable device by inserting at least a portion of an antenna unit into the communication module.*

Respectfully, Applicant submits that Kaschke fails to teach or suggest disabling a communication module as recited in claim 17 or related limitations recited in independent claim 11. Since Kaschke only discloses changing modes of operation in response to the antenna position and not disabling a communication module as recited in claims 1-20, Kaschke cannot anticipate Applicant's claims. For the foregoing reasons, Applicant respectfully requests the Examiner to reconsider and withdraw the §102(b) rejections of record.

**35 U.S.C. § 103**

Claims 1-10 are rejected under 35 U.S.C. § 103(a) as being unpatentable over U.S. Patent 6,336,039 to Usui in view of Kaschke. Applicant respectfully traverses this rejection for the following reasons.

It is respectfully submitted that a *prima facie* case of obviousness has not been established since: (i) there is no suggestion or motivation, either in the references themselves or in the knowledge generally available to one of ordinary skill in the art, to modify the references or to combine reference teachings as suggested in the Office Action; and (ii) even when

RESPONSE under 37 C.F.R. § 1.116  
U.S. Appln. No. 09/745,923

combining the cited references as suggested, the prior art references when combined fail to teach or suggest each and every claim limitation. Without both of these elements, a *prima facie* case of obviousness is not established and a rejection under 35 U.S.C. § 103(a) is improper (MPEP 2143).

(i) THERE IS NO MOTIVATION TO COMBINE REFERENCES

The mere fact that references can be combined or modified does not render the resultant combination obvious unless the prior art also suggests the desirability of the combination. *In re Mills*, 916 F.2d 680, 16 USPQ2d 1430 (Fed. Cir. 1990).

In the instant case the Office Action alleges it would be obvious to combine the position responsive antenna disclosed by Kaschke with the Usui system "to provide the convenient for user operation and protection from accidental activation of exposed control keys." (2/11/04 Final Office Action pg. 3). However, Usui already has a solution to prevent accidental activation of exposed control keys (e.g., dial button 121 or sheet switch 121a); see AND circuit 168; Fig. 9 and col. 10, ll. 38-65. Accordingly, Applicant respectfully submits the skilled artisan would not look to Kaschke to prevent wrong operation of Usui dial button 121 or sheet switch 121a since Usui already expressly discloses a specific solution to this potential problem.

As far as the rational for completely redesigning the Usui system with the position responsive antenna disclosed by Kaschke being allegedly "convenient," Applicant respectfully submits this conclusory, over-generalized and unsupported speculation is not an objective reason sufficient to establish *prima facie* obviousness. See, *Ex parte Levengood*, 28 USPQ2d 1300 (Bd. Pat. App. & Inter. 1993).

Since there is no proper motivation for combining the Kaschke with Usui, the rejection of claims 1-10 under 35 U.S.C. § 103(a) is improper.

(ii) THE RESULTING COMBINATOIN FAILS TO TEACH THE CLAIMED LIMITATIONS

RESPONSE under 37 C.F.R. § 1.116  
U.S. Appln. No. 09/745,923

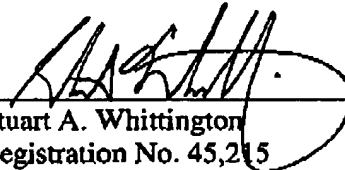
Even assuming that it would be proper to combine the references as suggested by the Office Action (*arguendo*), the resultant combination would still fail to teach or suggest *an antenna unit adapted to disable a communication module when in a first position* as recited in claims 1-10. As discussed above, Kaschke discloses only changing a mode of operation (i.e., from "on-hook" to "off-hook" responsive to the movement of antenna 212. Since Kaschle and Usui, taken alone or in combination, fails to teach or suggest disabling a communication module based on the position of the antenna, Kaschle and Usui cannot render obvious claims 1-10.

Because the suggested combination of prior art references is improper and because taken alone or in combination the prior art references fail to teach or suggest each and every claimed limitation, Applicant respectfully submits a *prima facie* case of obviousness under 35 U.S.C. § 103(a) has not been established. Accordingly, reconsideration and withdrawal of the §103 rejection is respectfully requested.

**CONCLUSION.**

In view of the above, reconsideration and allowance of this application are now believed to be in order, and such actions are hereby solicited. If any points remain in issue which the Examiner feels may be best resolved through a personal or telephone interview, the Examiner is kindly requested to contact the undersigned at the telephone number listed below. Applicant hereby petitions for any extension of time which may be required to maintain the pendency of this case, and any required fee or deficiency thereof, except for the Issue Fee, is to be charged to **Deposit Account # 50-0221.**

Respectfully submitted,

  
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